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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,597	02/04/2004	James D. Ralph	F-308	3441

51640 7590 02/23/2006

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EXAMINER	
HOFFMAN, MARY C	
ART UNIT	**PAPER NUMBER**
3733	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/771,597	RALPH ET AL.	
	Examiner	Art Unit	
	Mary Hoffman	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-9 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 04 February 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is in claim format. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

There exists an inconsistency between the language of claim 1 and that of the claim 5 dependent thereon, thus making the scope of the claim unclear. In the preamble of claim 1, line 1, applicant recites "An instrument" with the intervertebral spacer being only functionally recited, i.e. "for holding an intervertebral spacer...", thus indicating that the claim is directed to the subcombination, "An instrument". However, in claim 5, lines 2-4, applicant positively recites the intervertebral spacer as part of the invention, i.e. "the intervertebral spacer comprises a cylindrical member....", thus indicating that the combination, instrument and intervertebral spacer, is being claimed. As such, it is

unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claims are intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes claims 1-5 will be considered as being drawn to the subcombination, instrument.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by McKeever (U.S. Patent No. 801,151).

McKeever disclose an instrument capable of holding an intervertebral spacer, the instrument comprising a shaft having a proximal end forming a handle (ref. #3), and a distal end forming a claw subassembly. The claw subassembly including a first pincer (ref. #2) fixed at the distal end of the shaft and a second pincer (ref. #9) which is capable of being selectively rotated into and out of a holding association with the first pincer capable of holding and releasing, respectively, a spacer. The instrument further comprises an actuation mechanism for selectively rotating the second pincer. The second pincer is rotateably mounted to the shaft and is spring biased away from the first pincer (ref. #14). The actuation mechanism comprises a sliding member (ref. #16)

mounted to the shaft which is selectively moveable in the distal direction by a force sufficient to overcome the bias of the spring, the distally directed movement of the sliding member capable of causing the second pincer to move toward the fixed first pincer, and the subsequent reaction of the sliding member in a proximal direction causes the sliding member to disengage the second pincer and the permit the pincers to separate under the bias of the spring. The second pincer includes a tapered surface which is engaged by a corresponding surface of the sliding member, the engagement causes the second pincer to rotate relative to the first pincer. The pair of pincers, a first being fixed, and a second being coupled to the first in open-biased opposition; and a sliding element capable of translating into and out of engagement with the second pincer to close and opening the pair of pincers. The pair of pincers define an intervertebral spacer grasping enclosure having an access opening. An intervertebral spacer is capable of being passed for placement into the enclosure when the sliding element is out of engagement, and the spacer is capable of being securely maintained between the first and second pincers when the sliding element has been translated into engagement with the second pincer. The first and second pincers are mounted at the distal end of a common shaft, and the sliding element is capable of being translated along the shaft; and wherein the second pincer has a portion thereof which is engaged by the sliding element to close the pair of pincers. The second pincer is mounted to the common shaft by a pivot joint (ref. #10), and the portion of the second pincer which is engaged by the sliding element is a tapered surface, the angle of which tapered

surface, when engaged by the sliding element, is capable of causing the second pincer to rotate about the pivot joint, closing the first and second pincers.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 1 1 F.3d 1046, 29 USPQZd 2010 (Fed. Cir. 1993)*, In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)*, In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982)., In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)*, and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1 .130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 1-10, and 1-12 of U.S. Patent No. 6,976,988, 6,805,716, 6,478,80, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-9 of the application and claims 1-11, 1-10, and 1-12 of the patents lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claims 1-11, 1-10, and 1-12 is in effect a "species" of the "generic" invention of claims 1-9. It has been held that the generic invention is "anticipated" by the "species". See In re Goodman, 20 USPQ2d 2010 (Fed. Circ. 1993).

Since claims 1-9 are anticipated by claims 1-11, 1-10, and 1-12 of the patent, it is not patentably distinct from claims 1-11, 1-10, and 1-12.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER